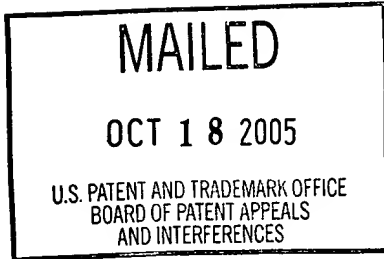


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER J. FITZGERALD, MARY C. BURGESS,
CHARLES E. BULLOCK and GLENN D. GOODNOUGH

Appeal No. 2005-1914
Application No. 09/494,156

ON BRIEF

Before McQUADE, NASE and BAHR, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Christopher J. Fitzgerald et al. appeal from the final rejection of claims 1 through 16, all of the claims pending in the application.

THE INVENTION

The invention relates to "an interactive system and method for on-line selection and purchase of an air conditioning product" (specification, page 1). Representative claims 1 and 5 read as follows:

1. An interactive method for on-line selection of an air conditioning product, comprising the steps of:

providing a database storing a plurality of air conditioning product identifiers and at least one corresponding product characteristic;

interactively obtaining intended use information from a consumer for a desired air conditioning product and intended use location;

equating said intended use information with an intended use product characteristic;

identifying a suitable product having said at least one product characteristic meeting said intended use product characteristic; and

identifying said suitable product to said consumer.

5. An interactive method for on-line selection of an air conditioning product, comprising the steps of:

providing a database storing a plurality of air conditioning product identifiers and at least one corresponding product characteristic;

interactively obtaining intended use information from a consumer for a desired air conditioning product and intended use location;

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equating said intended use information with an intended use product characteristic;

identifying a suitable product having said at least one product characteristic meeting said intended use product characteristic; and

identifying said suitable product to said consumer,

wherein said corresponding product characteristic includes a BTU rating for each product, and wherein said step of interactively obtaining comprises:

obtaining intended use location area from said consumer;
transforming said intended use location area into an initial acceptable BTU capacity for said intended use location area;

obtaining further intended use location information from said consumer;

determining a correction factor from said further intended use location information; and

applying said correction factor to said initial acceptable BTU capacity so as to obtain a corrected acceptable BTU capacity, and wherein said equating step comprises identifying said suitable product having said BTU rating meeting said corrected acceptable BTU capacity.

THE PRIOR ART

The items relied on by the examiner to support the final rejection are:

Farrell et al. (Farrell)	6,282,518	Aug. 28, 2001
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Lonngren, "Get Cookin' It's Time to Put 'Cool' on the Front Burner," Chicago Tribune (May 26, 1995).

Sheinkopf, "Air-Conditioner Alphabet Soup," Dallas Morning News (June 30, 1995).

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Steele, "Don't Get Hot and Bothered About Buying AC Go To An Air-Conditioning Showroom Armed With Specific Information That Will Affect Your Cooling Needs," Chicago Tribune (July 15, 1996).

PR Newswire, "Air Conditioners Are More Than Cool Air - Insider Tips for Shoppers" (July 23, 1998).

Official Notice taken by the examiner that a database storing a range of products including a plurality of individual characteristics is old and well known in the art.

THE REJECTIONS

Claims 1 through 5, 8 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over PR Newswire in view of Farrell.

Claims 6, 7 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over PR Newswire in view of Farrell and Steele.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over PR Newswire in view of Farrell and Sheinkopf.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over PR Newswire in view of Farrell and Lonngren.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over PR Newswire in view of Farrell, Lonngren and Sheinkopf.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over PR Newswire in view of Farrell, Steele and Lonngren.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over PR Newswire in view of Farrell and Official Notice.

Attention is directed to the brief (filed April 21, 2004) and the final rejection and answer (mailed July 17, 2003 and August 12, 2004) for the respective positions of the appellants and examiner regarding the merits of these rejections.

DISCUSSION

I. The rejection of claims 1 through 5, 8 and 15

The PR Newswire article discusses tips for people shopping for an air conditioner. Cautioning that consumers should do their own research and/or rely on a trained sales counselor to ensure that they purchase a product having a BTU output suitable for their needs, the article teaches that an appropriate BTU output depends on a number of factors. The factors mentioned include the size, i.e., square footage, of the room or area to be cooled or dehumidified ("[u]nits with a small BTU output will not cool larger rooms" and "[i]f you select a unit too large for the area to be cooled, the area will cool before the proper amount of humidity is

removed") and the tendency of the room or area to become excessively hot ("[f]or rooms where heat is created, like the kitchen, or areas that are exceptionally hot, like attic rooms, a larger BTU output is desirable").

Farrell discloses "a process for making industrial products available by the manufacturer . . . for ordering through the Internet by a customer" (column 1, lines 6 through 9). According to Farrell, the use of such electronic means to effect purchases from a manufacturer affords consumers the benefits of reducing the time required to fill an order and eliminating the necessity for, and hence the cost associated with, an intermediate entity through which an order would otherwise pass (see column 2, lines 28 through 46). As described in the reference,

there is provided a new and improved process for making available industrial products by the manufacturer thereof for online ordering by customers through a communications network accessible to the customers, the industrial products being made available based upon a selection by the manufacturer of such industrial products as a subset of an inventory set of industrial products, and for querying such customers as to their desire to place an order for at least one of the selected industrial products. The subject process of the present invention includes the steps of effecting an identification by the manufacturer of the key parameters involved in a selection of a subset of the industrial products from an inventory set of industrial products wherein the inventory set of industrial products includes all of the industrial products that may be made available by the manufacturer for online ordering by customers through a

communications network, placing such key parameters for the industrial products in a database of the industrial products that are available for ordering by the customer, making the database of the industrial products that are available for ordering by a customer accessible through the communications network to any customer for such industrial products having access to the communications network, effecting a connection by a customer for such industrial products through the communications network to the database containing the key parameters for the industrial products, effecting a request by the manufacturer through the communications network for specific information from the customer for subsequent assessment of such requested specific information with respect to the key parameters for the industrial products in the database containing key parameters for the industrial products, effecting an identification by the manufacturer of a subset of industrial products based on an assessment of the requested specific information provided by the customer for the industrial products relative to the key parameters for the industrial products contained in the database wherein the subset of industrial products includes at least one particular industrial product selected by the manufacturer based upon the suitability of the at least one particular industrial product for meeting a specific requirement of the customer for an industrial product, and effecting a query through the communications network as to whether the customer for the industrial products desires to place an order with the manufacturer for the at least one particular industrial product identified by the manufacturer based upon the suitability of the at least one particular industrial product for meeting a specific requirement of the customer for an industrial product [column 7, lines 10 through 57].

In combining PR Newswire and Farrell to reject independent claim 1, the examiner submits that the collective teachings of these references would have suggested the appellants' invention "because storing a plurality of air conditioning products and their corresponding characteristics on a database would enable customers to shop for air conditioners online . . . [and] would greatly enhance customer convenience by enabling the purchase of an air conditioner from any location with Internet access" (answer, page 4).

The appellants contend that the rejection of claim 1 is unsound because "[t]hese references contain insufficient teaching to combine them, and such combination if done does not arrive at the present invention" (brief, page 4). More particularly, the appellants argue that PR Newswire does not teach or suggest an on-line interactive method of shopping for an air conditioner, that Farrell, while disclosing an on-line interactive shopping process generally applicable to industrial products, relies on but a single identification of information from the consumer to select a product, and that PR Newswire actually teaches away from the proposed combination with Farrell through its recommendation of research and/or a trained sales counselor to accomplish a suitable purchase (see pages 4 and 5 in the answer).

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

In the present case, the appellants' observation that PR Newswire does not teach or suggest an on-line interactive method of shopping for an air conditioner is accurate and conceded by the examiner. Nonetheless, the description by Farrell of the benefits of interactive on-line systems for purchasing products would have provided the artisan with ample suggestion or motivation to implement air conditioner purchases as disclosed by PR Newswire, including the consideration of intended use location to derive a corresponding product characteristic (e.g., BTU output) and products, via an interactive on-line process of the type disclosed by Farrell. Nothing in PR Newswire, including the advice to use research and/or a trained sales counselor, teaches away from this combination. Furthermore, and contrary to the position taken by the appellants, the resulting method would respond to all of the limitations in claim 1. In this regard, the interactive display

screens illustrated in Farrell's Figures 4 and 5 belie the appellants' contention that Farrell discloses but a single identification of information from the consumer to select a product. Moreover, even if the disclosure of Farrell were so restricted, claim 1 contains no limitation which excludes or is otherwise inconsistent with a single identification of information.

Hence, the combined teachings of PR Newswire and Farrell justify the examiner's conclusion that the differences between the subject matter recited in claim 1 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Accordingly, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 1 as being unpatentable over PR Newswire in view of Farrell.

We also shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 2 through 4 as being unpatentable over PR Newswire in view of Farrell since the appellants have not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claim 1 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

We shall not sustain, however, the standing 35 U.S.C. § 103(a) rejection of independent claim 5 and dependent claims 8 and 15 as being unpatentable over PR Newswire in view of Farrell.

Claim 5 is more limited than claim 1 by virtue of its recitation of the steps relating to the generation of an initial acceptable BTU capacity, a correction factor and a corrected acceptable BTU capacity. The examiner's determination that PR Newswire teaches or would have suggested such steps (see pages 5 and 6 in the answer) finds no factual support in the fair teachings of this reference and instead rests on unfounded speculation as to how the intended use factors discussed by PR Newswire might be utilized to select a suitable air conditioner.

II. The rejections of claims 6, 7, 9 through 14 and 16

As the examiner's various applications of Steele, Sheinkopf, Lonngren and/or Official Notice do not overcome the above noted deficiencies of PR Newswire and Farrell relative to the subject matter recited in parent claim 5, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 6, 7 and 14 as being unpatentable over PR Newswire in view of Farrell and Steele, the standing 35 U.S.C. § 103(a) rejection of dependent claim 10 as being unpatentable over PR Newswire in view of Farrell and Sheinkopf, the standing 35 U.S.C. § 103(a) rejection of dependent

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claims 11 and 12 as being unpatentable over PR Newswire in view of Farrell and Lonngren, the standing 35 U.S.C. § 103(a) rejection of dependent claim 13 as being unpatentable over PR Newswire in view of Farrell, Lonngren and Sheinkopf, the standing 35 U.S.C. § 103(a) rejection of dependent claim 9 as being unpatentable over PR Newswire in view of Farrell, Steele and Lonngren, or the standing 35 U.S.C. § 103(a) rejection of dependent claim 16 as being unpatentable over PR Newswire in view of Farrell and Official Notice.

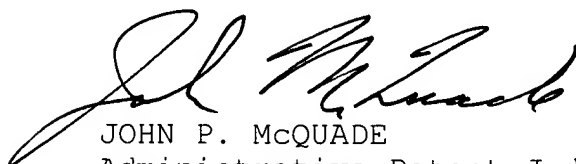
SUMMARY


The decision of the examiner to reject claims 1 through 16 is affirmed with respect to claims 1 through 4 and reversed with respect to claims 5 through 16.

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No time period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART


JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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